



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,409	06/07/2001	Bruce M. Ruana	RUANA-002	7700

7590 01/31/2003
Kristin C. Castle
Sierra Patent Group
P.O. Box 6149
Stateline, NV 89449

EXAMINER

GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
----------	--------------

3612

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/877,409

Applicant(s)
Ruana

Examiner
Hilary Gutman

Art Unit
3612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 13, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above, claim(s) 1-14, 30-42, and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-29, 43-56, and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jan 13, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3612

DETAILED ACTION

Election/Restriction

1. This application contains claims drawn to an invention nonelected without traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 1/13/2003 have been acknowledged and approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

On page 2, line 15, "hanging" should perhaps be "hangings".

On page 11, the replacement paragraph includes underlining and brackets which is not appropriate and confusing. The underlining should not be underlined and the bracketed words should be deleted along with the brackets themselves.

On page 11, the last paragraph (starting on line 16) is repetitive and should be deleted.

On page 12, lines 10-15 appear to be repetitive and confusing. Furthermore, the applicant should stick with either top/bottom surface or inner and outer surface (now stated) but not both.

Art Unit: 3612

Furthermore, the chosen phrase top/bottom or inner/outer by the applicant should be consistently maintained throughout the specification and claims for clarity. It should be noted that an inner surface and an outer surface are apparently recited in the claims.

On page 13 the first paragraph (lines 1-11) is repetitive and should perhaps be deleted.

Also on lines 15, 16, 17, 19, and 20, reference number "130" should be "120" to correspond with the drawing figures.

On page 14, line 1, "130" should be "120" to correspond with the drawings.

Appropriate correction is required.

4. The use of the trademarks Flexicon (pages 7, 8, and 9) and mylar (page 7) has been noted in this application. These trademarks should be accompanied by the generic terminology wherever they appear.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

5. The claims are objected to because they include reference characters which are not enclosed within parentheses.

Art Unit: 3612

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Specifically, in claim 58, line 5, "grip 6" is recited with no parentheses.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15-29, 43-56, and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, it is unclear how the stretchable layer is able to "stretch" while being permanently adhered to the backing layer, which may not "stretch".

Claim 23 recites the limitation "its length" in line 2. There is insufficient antecedent basis for this limitation in the claim.

For claims 25-28, the phrases "sublimation printing", "heat pressure transfer process", "wet ink printing", and "digital graphics" are all considered processes making these claims product-by-process claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim(s) is the same as or obvious from a

Art Unit: 3612

product of the prior art, the claim(s) are unpatentable even though the prior product was made by a different process (MPEP 2113).

Claim 43 recites the limitation "a railing" in line 3. There is insufficient antecedent basis for this limitation in the claim. Also in claim 43, it is unclear how the stretchable layer is able to "stretch" while being permanently adhered to the backing layer, which may not "stretch".

Claim 50 recites the limitation "its length" in line 2. There is insufficient antecedent basis for this limitation in the claim.

For claims 52-55, the phrases "sublimation printing", "heat pressure transfer process", "wet ink printing", and "digital graphics" are all considered processes making these claims product-by-process claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim(s) is the same as or obvious from a product of the prior art, the claim(s) are unpatentable even though the prior product was made by a different process (MPEP 2113).

Claim 58 recites a method "of claim 24" in the preamble but later recites "of claim (24)" in the body of the claim (at line 5) which is improper. The dependency of the claim should be stated in the preamble only and not in the body of the claim. Furthermore, the method claim is dependent upon a product claim which is not proper.

Claim 58 recites the limitations "a grip" and "grip" on line 5 and "its length" in line 4. There is insufficient antecedent basis for these limitations in the claim.

Art Unit: 3612

Allowable Subject Matter

8. Claims 15-29, 43-56, and 58 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

9. Applicant's arguments filed 1/13/2003 have been fully considered but they are not persuasive. The applicant believes that the modifications to the drawings, specification, and claims has overcome the examiners objections and rejections and places the case in condition for allowance, however, this is not the case. The applicant has not fully overcome all of the specification and claim objections and furthermore, has not modified the claims to overcome each and every 112 second paragraph rejection of the claims. Due to the applicant's failure to overcome all of the rejections set forth, the case is not in condition for allowance and the rejections previously stated in the office action (mailed 10/29/2002) are maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3612

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication from the examiner should be directed to Hilary L. Gutman whose telephone number is (703) 305-0496.

12. **Any response to this final action should be mailed to:**

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

or faxed to:


(703)305-3597, (for formal communications; please mark "EXPEDITED PROCEDURE")

or:

(703)305-0285, (for informal or draft communications, please clearly label "PROPOSED" or "DRAFT").

hlg

January 27, 2003


D. GLENN DAYOAN 1/29/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600